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August 17, 2004

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\*Admitted only in Maryland • Admitted only in Virginia • Practice Limited to Federal Agencies

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Art Unit 2623

Commissioner for Patents PO Box 1450 Alexandrià, VA 22313-1450

Re:

U.S. Utility Patent Application

Application No. 10/725,541; Filed: December 3, 2003

System and Method for Generating a Preview Display in a Print

Capturing System Using a Non-Planar Prism

Inventors:

McClurg et al.

Our Ref:

1823.082000A

Sir:

Transmitted herewith for appropriate action are the following documents:

- 1. Information Disclosure Statement (IDS);
- 2. Form PTO-1449 (9 sheets) listing the cited documents;
- Copies of the five(5) cited documents; and 3.
- 4. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg

Attorney for Applicants

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McClurg et al.

Appl. No.: 10/725,541

Filed: December 3, 2003

For: System and Method for Generating

a Preview Display in a Print Capturing System Using a Non-

**Planar Prism** 

Confirmation No.: 3188

Art Unit: 2623

Examiner: A. Au

Atty. Docket: 1823.082000A

## **Information Disclosure Statement**

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

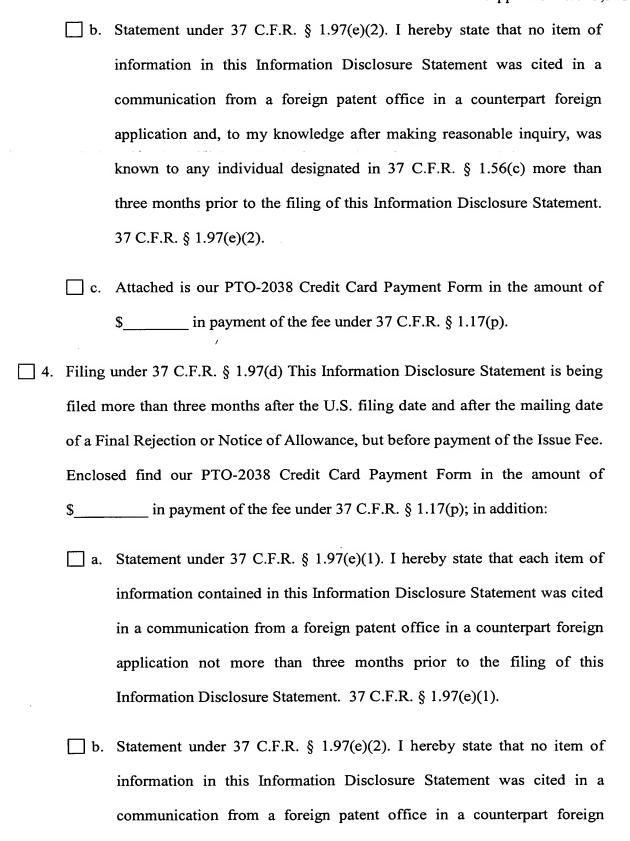
Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this
  Information Disclosure Statement was cited in a communication from a foreign
  patent office in a counterpart application and this communication was not
  received by any individual designated in 37 C.F.R. 
  § 1.56(c) more than thirty
  days prior to the filing of this information disclosure statement.
- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
  - a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).



application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

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⊠ 5.	Documents AH1, AB3, AB4, and AD5 were cited in a search report in a
	counterpart PCT application. A copy of the search report is enclosed as
	document AN1 for the convenience of the Examiner.
<b>⊠</b> 6.	A concise explanation of the relevance of the non-English language document
	AK1 appears below:
	Document AK1 (JP 3-161884) appears to describe a finger image input device.
	An English language abstract of document AK1 is enclosed as document AO1.
⊠ 7.	Copies of documents AJ1, AK1, AN1, AO1, and AP1 are submitted herewith.
<b>8.</b>	Copies of the documents were cited by or submitted to the Office in an IDS that
	complies with 37 C.F.R. § 1.98(a)-(c) in Application No, filed
	, which is relied upon for an earlier filing date under 35 U.S.C.
	§ 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
<b>9</b> .	No copies of U.S. patents and patent application publications cited on the
	attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because
	this application was filed after June 30, 2003.
<u> </u>	. It is expected that the examiner will review the prosecution and cited art in the
	parent application no(s) in accordance with MPEP 2001.06(b), and

indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg

Attorney for Applicants
Registration No. 43,447

Date:

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Page 1 of 9 ATTY, DOCKET NO. APPLICATION NO. AUG 1 7 2004 1823.082000A 10/725,541 FORM PTO-1449 **INVENTORS** McClurg et al. INFORMATION DISCLOSURE **ART UNIT** FILING DATE December 3, 2003 2623 **U.S. PATENT DOCUMENTS EXAMINER DOCUMENT NUMBER** DATE NAME CLASS SUB-CLASS **FILING DATE** INITIAL AA1 2,184,858 12/1939 Goodman AB1 3,054,854 09/1962 Neasham AC1 3,282,152 11/1966 Myer 08/1967 AD1 3,333,502 Flanagan 05/1970 AE1 3,511,571 Ogle AF1 3,648,240 03/1972 Jacoby et al. 02/1973 Caulfield et al. AG1 3,716,301 AH1 3,765,018 10/1973 Heard et al. AI1 3,804,524 04/1974 Jocoy et al. **FOREIGN PATENT DOCUMENTS EXAMINER** INITIAL DOCUMENT NUMBER DATE COUNTRY CLASS SUB-CLASS **TRANSLATION** AJ1 WO 96/17480 A2&A3 06/1996 PCT N/A JP 3-161884 07/1991 JP No AK1 Yes AL1 No Yes AM1 OTHER (Including Author, Title, Date, Pertinent Pages, etc.) International Search Report from PCT Appl. No. PCT/US03/38644, filed December 5, 2003, AN 1 3 pages. English Abstract for Japanese Patent Publication No. 3-161884, published July 7, 1991, 1 AO 1 page, from http://v3.espacenet.com/. McClurg et al., U.S. Patent Appl. No. 10/725,543, filed December 3, 2003, entitled "System Having a Rotating Optical System and a Non-Planar Prism that are Used to Obtain Print and AΡ 1 Other Hand Characteristic Information," 41 pages. AQ 1 AR 1 DATE CONSIDERED **EXAMINER EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance

and not considered. Include copy of this form with next communication to Applicant.

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	AA2	;	3,882,462	05/1975	Mo	cMahon					
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	AE2	4	1,206,441	06/1980	Ko	ondo					
	AF2	- 4	4,206,556	06/1980	Sa	abo <i>et al</i> .					
	AG2	- 4	4,357,597	11/1982	Ви	utler					
	AH2		4,387,365	06/1983	Be	erry et al.					
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	AA3		4,4	67,545 	08/1984	SI	haw, Jr.					
	AB3		4,5	78,793 	03/1986	K	ane <i>et al.</i>		_			
***	AC3		4,688,092		08/1987	K	amel <i>et al</i> .					
	AD3		4,701,960		10/1987	S	cott					
	AE3		4,720,869		01/1988	W	/adia					
	AF3		4,736,203		04/1988	Si	idlauskas					
	AG3		4,736,436		04/1988	Y	asukawa <i>et al</i> .					
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	AA4		4,7	74,516 	09	9/1988	Н	enri <i>et al</i> .					
	AB4		4,7	90,025	12	2/1988	In	noúe <i>et al</i> .					
	AC4		4,805,117		02	02/1989		iore <i>et al</i> .			- v-		
	AD4		4,821,118		04	04/1989		afreniere					
	AE4		5,140,469		90	3/1992	Li	amarre et al.					
	AF4		5,225,924		07	7/1993	0	gawa <i>et al.</i>					
	AG4		5,2	49,370	10	0/1993	s	tanger et al.					
	AH4		5,3	07,264	04	1/1994	W	/aggener et al.					
	Al4		5,3	09,274		5/1994		kanabe					
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	AA5		5,313,30	6	05/1994	K	uban <i>et al.</i>							
	AB5		5,367,39	9	11/1994	K	ramer							
	AC5	;	5,377,00	2	12/1994	N	lalin et al.		-					
	AD5		5,440,42	8	08/1995	H	egg et al.							
	AE5		5,452,13	5	09/1995	N	laki <i>et al</i> .							
	AF5		5,469,28	9	11/1995	IN	vao <i>et al.</i>							
	AG5		5,526,43	6	06/1996	s	ekiya 							
	AH5		5,528,35	5	06/1996	N	laase <i>et al.</i>							
	AI5		5,588,09		12/1996		no et al.							
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	AA6		5,6	10,751	03/1997	Sv	veeney et al.				
	AB6		5,6	38,461	06/1997	Fr	idge				
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	AD6		5,677,782		10/1997	Pe	eng				
	AE6		5,699,186		12/1997	Ri	chard				
	AF6		5,777,751		07/1998	w	ard				
	AG6		5,796,426		08/1998	Gı	ullichsen <i>et al</i> .				
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			3,488 B1	06/2001	P	enna					
	AG7		6,341,028 B1		01/2002	В	ahuguna <i>et al.</i>				
	AH7 6,394,356 B1		94,356 B1	05/2002	Za	agami					
	AI7		6,41	1,441 B1	06/2002		Videen				
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